

follows, pursuant to 37 C.F.R. §§ 1.121(h) and 1.173(b) (relating to reissue applications):

IN THE CLAIMS

Cancel Claim 58 without prejudice and without disclaimer of subject matter.

Please amend Claim 60 to read as follows.

60. (Amended) The method of Claim 59, wherein the metal particle comprises Pd.

REMARKS

Claims 1-6, 8, 9, 11, 12, 15, 16, 18-23, 26-28, 31-43, 45, 49-57, and 59-62 remain pending in this reissue application. Claim 58 has been canceled without prejudice and without disclaimer of subject matter. Claim 60 has been amended to remove its dependency from canceled Claim 58, and now depends from Claim 59 only.

The Office Action states that a supplemental declaration is required to cover errors corrected by the claim changes which have been made since the previous supplemental declaration was filed. Claims 1-6, 8, 9, 11, 12, 15, 16, 18-23, 26-28, 31-43, 45, and 49-62 were rejected as being based on a defective reissue declaration under 35 U.S.C. § 251, for the same reasoning. The Office Action states that Claims 1-6, 8, 9, 11, 12, 15, 16, 18-23, 26-28, 31-43, 45, 49-57, and 59-62 would be allowed if a proper supplemental reissue declaration were to be filed.

According to Applicants' understanding of MPEP § 1444, Applicants may

wait until the reissue application is otherwise in condition for allowance before submitting the required supplemental declaration under 35 C.F.R. § 1.175(b), since a declaration complying with 37 C.F.R. § 1.175(a) already has been submitted in this application.<sup>1</sup> Accordingly, Applicants respectfully request to defer the filing of the supplemental declaration to overcome the Section 251 rejection until the application is otherwise in condition for allowance.<sup>2</sup> Of course, if the Examiner believes that the supplemental declaration cannot be deferred, he is respectfully requested to contact the undersigned attorney.

Claim 58 was rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter that allegedly was previously surrendered. Claim 58 also was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 3,611,077 (Smith).

Applicants strongly believe that Claim 58 is patentable for the reasons given on page 19, lines 9-13 of the Amendment And Response To Office Action filed on October 23, 2002. Nonetheless, without conceding the propriety of the rejections of Claim 58 set forth in the Office Action, Claim 58 has been canceled, thereby rendering those rejections moot. Accordingly, withdrawal of those rejections is respectfully requested.

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<sup>1/</sup> This course of action would avoid having to submit a supplemental declaration each time an amendment is filed in this application.

<sup>2/</sup> In any event, cancellation of Claim 58 renders the Section 251 rejection of that claim moot. A supplemental reissue declaration complying with 37 C.F.R. § 1.175(b)(1) is in preparation, and will be filed shortly.

**REQUEST FOR RECONSIDERATION OF  
IMPROPER FINALITY OF OFFICE ACTION**

Applicants respectfully submit that the finality of the outstanding Office Action is improper and should be withdrawn, for the following reasons. MPEP § 706.07(a) explicitly mandates that only second or subsequent actions *on the merits* shall be made final. In the earlier Office Action dated July 23, 2002, Claims 1-5 and 42 were not treated on the merits. Those claims were treated on the merits only once (in the outstanding Office Action) since prosecution on the merits was reopened by the non-final Office Action (see page 2 thereof) mailed on July 23, 2002, which set forth new grounds of rejection which were not set forth in any prior Office Actions in this case. Since Claims 1-5 and 42 have not been treated on the merits more than once since prosecution on the merits was reopened, the finality of the outstanding Office Action is believed to be improper under MPEP § 706.07(a), and therefore withdrawal of that “final” status of the outstanding Office Action is respectfully requested.<sup>3</sup>

**(CONDITIONAL) PETITION UNDER 37 C.F.R. § 1.181**

If the Examiner does not agree to withdraw the finality of the outstanding Office Action in view of the foregoing, this paper should be treated as a petition to invoke the supervisory authority of the Commissioner under 37 C.F.R. § 1.181, and should be forwarded along with the file wrapper to the appropriate official for decision.

Although no fee is believed due in view of the U.S. Patent and Trademark

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Applicants presently intend to file an Information Disclosure Statement in this application shortly, in accordance with 37 C.F.R. § 1.97(c)(2).

Office's error in labeling the Office Action "final", any fee that may be deemed due for the petition may be charged to Deposit Account No. 06-1205.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and allowance of the present reissue application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

  
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